Reply to Office Action of August 1, 2005

Docket No.: 05986/100K521-US1

<u>REMARKS</u>

Reconsideration of the application in light of the amendments and the following remarks is respectfully requested.

Status of the Claims

Claims 1, 10 and 18 have been amended. No new matter is added.

Claims 37 and 38 are cancelled.

Claims 1-36 are currently pending.

Restriction of the Claims

Claims 37 and 38 stand withdrawn as being directed to a non-elected invention. The Examiner states that muscle tissue is different than neural tissue and contends that a method and apparatus for sensing activity of muscle tissue would require a separate search in the art. Claims 37 and 38 have been cancelled rendering the restriction moot.

Allowable Subject Matter

Applicants would like to thank the Examiner for the indication that claims 5, 27, 29 and 31 contain allowable subject matter. The Examiner states that these claims are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Rejections of the Claims

Claims 1, 2, 10, 26 and 28 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,515,848 to Corbett, III et al. ("Corbett '848") in view of U.S. Patent No. 5,201,903 to Corbett, III et al. ("Corbett '903").

Claims 2-4, 7, 8, 11, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Corbett '848 and further in view of U.S. Patent No. 5,883,603 to Kovacs et al. ("Kovacs").

Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Corbett '848 in view of Kovacs and further in view of U.S. Patent No. 6,615,067 to Hoek.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Corbett '848 in view of Kovacs and further in view of U.S. Patent No. 4,913,160 to John.

Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Corbett '848 in view of Corbett '903 and further in view of U.S. Publication No. 2002/0117659 to Lieber et al. ("Lieber").

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Corbett '848 in view of Kovacs, John and Lieber.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Corbett '848 in view of Corbett '903 and Lieber and further in view of U.S. Patent No. 5,391,147 to Imram.

Claims 18-21 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,651,767 to Schulman et al. ("Schulman"), in view of Corbett '848.

Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Schulman in view of Corbett '848 and further in view of Lieber.

Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schulman in view of Corbett '848 in view of Lieber, and further in view of U.S. Patent No. 6,662,731 to Daniel et al.

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Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Schulman

in view of Corbett '848, and further in view of Lieber and further in view of Imram.

Claims 32-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Corbett

'848 and further in view of U.S. Patent No. 6,374,140 to Rise.

Applicant has amended independent claims 1 and 18 to recite a method including the

step of placing an electrode that is smaller than 10 µm into a blood vessel proximate to neural

tissue. Claim 10 has been amended to recite a device including an electrode that is smaller than 10

μm. The small size allows the electrode to be inserted into capillaries. As discussed with the

Examiner during the October 10, 2005 interview, none of the cited references disclose or suggest an

apparatus or method including an electrode that is small enough to be inserted into capillaries, i.e.

smaller than 10 µm. Thus, claims 1, 10 and 18 are patentable over the cited references.

Claims 2-9, 26, 27 and 32-36 depend from claim 1. Claims 11-17, 28 and 29 depend

from claim 10. Claims 19-25, 30 and 31 depend from claim 18. Claims 2-9, 11-17 and 19-36 are

patentable for at least the same reasons as their respective base claims.

CONCLUSION

Each and every point raised in the Office Action dated August 1, 2005 has been

addressed on the basis of the above remarks. In view of the foregoing it is believed that claims 1-36

are in condition for allowance and it is respectfully requested that the application be reconsidered

and that all pending claims be allowed and the case passed to issue. A prompt and favorable action

in that regard is earnestly solicited.

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If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

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Respectfully submitted,

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